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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,280	01/29/2001	Yves Fouillet	GENSET.077CP1	9257

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KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

EXAMINER

TUNG, JOYCE

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 06/20/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/772,280	Applicant(s) FOUILLET ET AL.	
	Examiner Joyce Tung	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>37</u> | 6) <input checked="" type="checkbox"/> Other: <i>Detailed Action</i> . |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1637.

Election/Restriction

1. Applicant's election without traverse of Group I, claims 1-32 in Paper No. 6 is acknowledged.
2. Claims 33 and 37 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, claims 33 and 37, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 9-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. Claims 9-32 are vague and indefinite because of the language "is capable of" in claim 9. It is unclear whether the thermal transfer member is cycling or not. Clarification is required.
- b. Claim 21 is vague and indefinite because of the language "in small steps". It is unclear what is the definition for the "small steps". Clarification is required.
- c. Claim 24 is vague and indefinite because of the language "in a humid atmosphere". It is unclear what kind of humid atmosphere is needed to perform the instant invention. Clarification is required.

Claim Rejections - 35 USC § 102

- 5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Corbett et al. (5,270,183).

Corbett et al. disclose a method for the amplification of DNA sequence using polymerase chain reaction in a cyclically heating and cooling reaction in which the reaction mixture is into a stream of carrier fluid going through different temperature zones (See column 3, lines 21-37). A tube carrying the stream of carrier fluid is made from plastic tube (See column 2, lines 34-42). The plastic tube has the same function as the wells for receiving samples as recited in the

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limitations of claim 2. The cycling can be occurred between different temperature zones up to 40 times as recited in claim 4. The method is involved using detection means (See column 8, lines 14-16). The temperature zone is provided with thermostatically controlled heating/cooling means (See column 6, lines 54-59). This teaching is inherent that the heating/cooling means can be a metal bar as indicated in the specification (See pg. 4, line 20). Thus the teachings of Corbett et al. anticipate the limitations of claims 1-8.

7. Claims 9-21 and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al. (6,375,817).

Taylor et al. disclose a method for rapid, automated, microscale sample analysis (See the Abstract). The method involved depositing liquid sample volumes into a plurality of sample receiving regions on at least one mobile sample transport member (See column 10, lines 6-9), and moving sample transport member along a pathway such that said sample receiving region move through at least one temperature regulated zone upon which a thermal transfer member acts, wherein said thermal transfer member is capable of cycling between at least two temperatures (See column 12, lines 36-61) (as recited in the limitations of claims 9-10, and 19-21) The sample receiving regions comprise areas on a substrate which has well having thin hydrophilic film on the bottom (See column 15, lines 42-45) (as recited in claims 11-18). The method involves PCR reaction (See column 12, lines 36-61) (as recited in claims 25-32). The thermal cycles through two temperatures are from about 2 to about 35 times (See column 12,

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lines 36-61) (as recited in claim 26). Thus, the teachings of Taylor et al. anticipate the limitations of claims 9-21 and 25-32.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

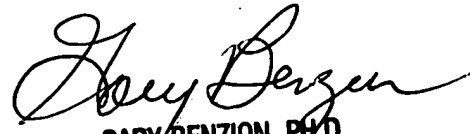
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

June 16, 2002


GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600